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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,627	03/28/2006	Heiko Roehm	3582	5660

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EXAMINER	
DIAO, M BAYE	
ART UNIT	PAPER NUMBER
2838	
MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/573,627	ROEHM ET AL.	
	Examiner	Art Unit	
	M'BAYE DIAO	2838	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 June 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Amendment

1. Acknowledgement is made of Amendment filed on 06/09/2008.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1 - 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nottingham, US 2003/0070511 in view of Kilmer et al., (Kilmer) US PAT 4,751,452 and further in view of Nakane et al., (Nakane) US PAT 6,191,554.

As per claim 1, Nottingham et al. disclose (pages 2-3, [0027]-[0034]) and show in Figs. 1-4:

a battery-operated screwdriver (10), having a housing (12, 16) with a handle (14), with a battery (20), wherein the battery-operated screwdriver (10) has a battery (20). Although Nottingham discloses a battery (20), Nottingham differs from the claimed invention because he does not specifically disclose the battery (20) being rechargeable and being designed as a lithium ion cell and placed on the charger shell , and the charging mode is produced automatically; and that the charger shell comprises at least one detachably mounted bit holder storing tool inserts of the battery- operated screwdriver in captive fashion.

Kilmer et al., disclose (col. 2, lines 37+; cols.3-4) and show in Figs. 1,4 7 & 8 a battery operated portable wire wrapping device (10) having either a rechargeable or non rechargeable battery pack (32) having electrical connections (42) and (44) (thus meeting the limitation of charge contact tongues) to mate with electrical connections (22) and (24) mounted in casing (20) of portable power tool (10) which is designed as a lithium ion cell (Li ion cell).

Kilmer also discloses that when it is desirable to recharge the battery pack (32), battery pack (32) is removed from the power tool casing (20)(housing) and then placed on a charger (50) (see Fig. 7).

Nottingham when modified by Kilmer still differ from the claimed invention because they both fail to disclose a charger shell which comprises at least one detachably mounted bit holder storing tool inserts.

Nakane et al., (hereinafter "Nakane") discloses (abstract; col. 7, lines 23+; col. 8, lines 24-30) and shows in Figs. 4-5, and 7: a power tool (30) charging system

including a motor (12), a charger (31)(Fig. 5) which includes a display window (27d) and a plurality of cylindrical tool bit holders (46) for inserting tool bit (47). The tool (30) includes a hydraulic unit (32) coupled to a nose or chuck (driven unit) (32a) **to which a tool bit is attached** (see col. 7, lines 23-35; col. 8, lines 1-50).

Nottingham when modified by Kilmer and combined with Nakane is evidence that ordinary workers in the art would find a reason, suggestion or motivation to use a rechargeable battery as a lithium ion cell that can be placed in a chronologically undefined way, particularly in intervals between uses, on a charger shell which comprises at least one detachably mounted bit holder for storing tools inserts.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a rechargeable battery such as a lithium ion cell or the like so as to enable utilization of both rechargeable and non rechargeable batteries while preventing the recharging of non-rechargeable batteries by use of a battery charger as per the teachings of Kilmer, (col. 1, lines 45-50).

Accordingly, claim 1 would have been obvious.

As per claims 2-4, Nottingham differs from the claimed invention because he does not specifically disclose the battery-operated screwdriver, wherein in the charging mode, the handle protrudes so far from the charger shell that for removing the battery-operated-screwdriver it is comfortably grasped from beneath and /or largely encircled with the hand, and wherein the charge contact tongues protrude outward through lateral slots in the lower end of the handle on both sides of the parting plane on the side of the internal angle and lock in the charging mode onto charge contacts of the charger shell,

without requiring that separate cords or coupling plugs be actuated, and wherein the battery-operated screwdriver, in the charging mode, fits with the indentations (33) in its handle (14) over the resilient charge contacts on the charger shell and is thus secured in overlocking fashion against unintentional release from the charger shell.

Kilmer et al. disclose (col. 2, lines 48+) and show in Figs 1 & 2 a portable tool (10) comprising a housing (20), which encloses both motor (12) section and power transmission section (18). The electrical connections (22) and (24) from electric motor (12) are mounted at the bottom (26) of housing (20) in opening (28) in which is mounted a battery pack (32) by two ear members (34) and (36) which fit into compatible slots (38) and (40) within opening (28). When engaged in opening (28), battery pack (32) has two electrical connections (42) and (44) which are placed into physical contact with the two compatible electrical connections (22) and (24) (construed as applicant charge contact tongues) in bottom (26) of portable power tool (10). Kilmer further discloses (col. 3, lines 43+) and shows in Figs. 3 - 6, the battery pack (32) being constructed with two halves (70) and (72) which allows the standard cell (48) (rechargeable) to be easily removed and replaced. Latches (74) and (76) connect the two halves (70 and 72) at top (54) and bottom (78).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the casing of the battery pack taught by Kilmer into the battery-powered screwdriver of Nottingham for advantages of serving as both handle and providing power to the motor of the portable power tool (col. 1, lines 59+), and ease

of operation by eliminating the cumbersome task of removing a screw or a nut to gain access to the batteries, (col. 3, lines 54-56) as per the teachings of Kilmer.

Accordingly, claims 2- 4 would have been obvious.

As per claim 5, Nottingham discloses (page 2,[0027]) and shows in Fig. 1 that the battery-operated screwdriver (10) as recited in claim 1, wherein the charger shell (charger shell being part of the handle (14)) has embedding means (19) on its top side for receiving the battery (20).

Nottingham differs from the claimed invention because he does not disclose the charger shell (which is also the handle (14)) having embedding means on its top surface for receiving the battery-operated screwdriver which correspond to a copy of its internal angle outer surfaces that are enclosed by the handle and the motor housing and the gearbox; and that at least one of the embedding means extends at an angle of less than 90° to the vertical.

Kilmer discloses (col. 2, lines 36+; col. 3, lines 62+; col. 4) and shows in Figs. 8 – 10, a charger shell (60) having embedding means (32',62,64) on its top surface (see Fig. 8) for receiving the portable power tool (10) (col. 2, lines 36+; col. 3, lines 62+; col. 4) which correspond to a copy of its internal angle outer surfaces that are enclosed by the handle (32') (considering the axis of (10) to be the vertical) and the motor housing (casing (20)) and the gear box (18) (see Fig. 2); and that at least one of embedding means (32') extends at an angle of less than 90° to the vertical (see Figure 1 below).

Accordingly, claim 5 would have been obvious.

As per claim 6, Nottingham differs from the claimed invention because he does not specifically discloses the battery-operated screwdriver as recited in claim 5 wherein the handle enters in wedgelike fashion only with its ON/OFF button into the embedding means of the charger shell, and the handle itself protrudes from the charger shell and dips only minimally into the embedding means.

Kilmer further discloses (col. 2, lines 37+; col. 3, lines 62+) and shows in Figs. 1-2 & 8-10, the portable power tool (10) having the handle (32) or (32') (see col. 1, lines 59-60) is used by inserting the battery pack (32) in opening (28) in casing (20) of the portable power tool (10) by twisting motion so as to cause the ears (34) and (36) to engage in slots (38) and (40). The power tool (10) has a trigger switch (30) which acts as an ON/OFF button not into the embedding means (32,62,64) but adjacent to them (see Fig. 1). Kilmer further discloses (see Figs. 1 & 8) the battery and handle (32) protruding from the charger shell (62) and dips only minimally (see Fig. 8 and the thickness of charger shell (60) compared to the height of the battery pack and handle (32)) into the embedding means.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made since the Applicant has no support data, which convinces that the particular claimed configuration is significant or is anything more than one of numerous configurations a person of ordinary skill in the art would find obvious for the purpose of providing mating surfaces. In re Dailey 149 USPQ 47, 50 (CCPA 1966). See also Glue Co. v. Upton 97 US 3,24 (USSC 1878).

Accordingly, claim 6 would have been obvious.

4. As per claim 7, Nottingham differs from the claimed invention because he does not specifically disclose that the charger shell is placeable, standing securely, on a flat and horizontal storage shelf, without having to be secured and firmly held when the battery-operated screwdriver is removed.

5. Kilmer does not specifically disclose (see Figs. 1 & 8; col. 3, lines 61+) that the charger shell (60)(see Fig. 8) is placeable, standing securely on a flat and horizontal storage shelf without having to be secured and firmly held when the power tool is removed, it is obvious that based on its shape (see Fig. 8) and since only twisting is involved for positioning the battery of the portable power tool, it is obvious to one of ordinary skill in the art at the time the invention was made to position the battery in to the charger shell without having to resort to firmly holding and securing. It is also obvious that the charger shell can be placed on a horizontal storage shelf and can be placed standing still since the tightening only involves twisting the battery until it locks into position as per the teachings of Kilmer, col. 3, lines 64-65.

6. Furthermore Nakane discloses(see Fig. 5) a charger shell (31) that is placeable standing securely on a flat and horizontal storage shelf, without having to be secured and firmly held when the battery-operated (30) is removed as shown in fig. 5.

7. Accordingly, claim 7 would have been obvious.

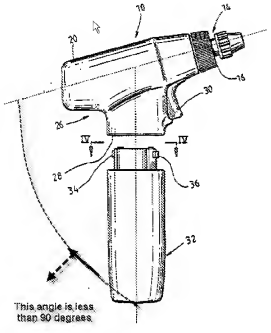

Fig. 1

8. Claims 8 - 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nottingham, US 2003/0070511 in view of Kilmer et al., (Kilmer) US PAT 4,751,452 and further in view of Nakane et al., (Nakane) US PAT 6,191,554 and further in view of Bennage et al., (Bennage) US PAT 6,702,530.

9. As per claims 8-9,15-16, Nottingham when combined with Kilmer differs from the claimed invention because he does not specifically disclose the charger shell having a detachably mountable bit holder particularly for receiving a plurality of bits, which in operation can be inserted, in particular plugged in, in a manner secure against relative rotation, in communication with the battery-operated screwdriver.

Nakane et al., (hereinafter "Nakane") discloses (abstract; col. 7, lines 23+; col. 8, lines 24-30) and shows in Figs. 4-5, and 7: a power tool (30) charging system including a motor (12), a charger (31) which includes a display window (27d) and a plurality of

cylindrical tool bit holders (46) for inserting tool bit (47). The tool (30) includes a hydraulic unit (32) coupled to a nose or chuck (driven unit) (32a) **to which a tool bit is attached** (see col. 7, lines 23-35; col. 8, lines 1-50).

Bennage et al. disclose (abstract; col. 2; col. 3, lines 1 - 20) and show in Figs. 1-4 a power tool (compact power drill)(10) wherein it has at least one, in particular detachably, mountable bit holder (12), particularly for receiving a plurality of bits (16,18), which in operation can be inserted, in particular plugged in, in a manner secure against relative rotation, in communication with the power tool (10)(as per claim 15). Bennage et al. further disclose (col. 1, lines 31-39; col. 2 lines 41+) that a hook (40) is formed on the retaining end 34, and it is the hook that applies a retaining force to the tool part (hex bit 16 or chuck key 18). This construction allows the tool part to be captured inside the recessed area (24) by the spring clip (30). When placing either the hex bit (16) or chuck key (18) into the recessed key and bit holder (12), the spring clip (30) bends so the tool part may be fitted into the recessed area (24)(which is obviously an equivalent of a groovelike indentation, as per claim 16). Once in the recessed area (24), the spring clip (30) applies force to the outside of the tool part, thereby holding it in place.

Nakane, and Bennage are evidence that ordinary workers in the art would find a reason, suggestion or motivation to include in the charger shell a detachable bit holder that is fitted flush into the outer contour in an overlockable fashion.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Nottingham by including in the charged shell for the

battery-operated screwdriver a detachably, mountable bit holder that is fitted flush into the outer contour of the charger shell in an overlockable fashion, for advantages such as adjusting the size of the mouth of the chuck key in the housing of the power tool to insert and remove drill bits, and to avoid losing the chuck key from a lose coupling, and also for advantages of storing extra bits on the power drill, as per the teachings of Bennage et al. (col. 1, lines 9-20).

Accordingly, claims 8-9, and 15-16 would have been obvious.

10. As per claim 17, Nottingham when combined with Kilmer and Nakane, discloses (Kilmer, col. 4, lines 59+) and shows in Figs. 1-2 that casing (20) and/or the housing surrounding the batteries in battery pack (32) may be formed of a strong, impact resistant insulating material like, a rubber or plastic based.

11. Accordingly, claim 17 would have been obvious.

12. As per claims 10-11, Nottingham when combined with Kilmer and Nakane differs from the claimed invention because they do not specifically discloses the charger shell having an elongated indentation for receiving bit holder, which indentation is longer than the bit holder and which, with the bit holder inserted, forms a permanent opening for grasping from below with a finger for the sake of removing the bit holder.

Bennage et al. disclose (col. 2; col. 3, lines 1-9) that in accordance with an important aspect of the present invention and referring to the embodiment of FIG. 1, the recessed key and bit holder (12) also has a finger relief cutout or cutout portion (42) formed in connection with the recessed area (24). The finger relief cutout portion (42) is

sized so as to accommodate at least one finger of the user. It is preferred that the finger relief cutout portion (42) be formed on the lower or bottom surface of the recessed area (24) and is in communication therewith, since the spring clip (30) is located near the top of the recessed area. To remove the tool part from the recessed key and bit holder (12), the user simply inserts a finger in the finger relief cutout portion (42) and pulls the tool part from the power tool (10).

Accordingly, claims 10-11 would have been obvious.

As per claim 12, Nottingham when combined with Kilmer, Nakane, and Bennage still differs from the claimed invention because they all do not disclose the charger shell as recited in claim 11, wherein the bit holder (12) is kept in a signal color red, and the charger shell is kept in a color black and/or dark green and/or dark blue. Nottingham when combined with Kilmer, Nakane and Bennage kept silent about the color of the power tool. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to make the color of the bit holder in red and that of the housing of the power tool in a color black and/or dark green and /or dark blue, since such a modification would have involved a mere change in the color of the portable tool and since they come in different color and size. A change in shape and/or color is generally recognized as being within the level of ordinary skill in the art.

Accordingly, claim 12 would have been obvious.

As per claims 13 – 14 Nottingham when modified by Kilmer, Nakane and Bennage disclose (Bennage col. 3, lines 21-54) and show in (Bennage,Figs. 4-5) the housing of the power tool having input pinions (88) for the bits (16, 18) which are

located extended perpendicular to the contour(head portion) of the power tool (50) as seen in Fig. 4.

Therefore it would have been obvious at the time the invention was made to provide with the charger shell taught by Nottingham a housing having a recessed key and bit holder wherein the recessed key and bit holder also has a finger relief cutout or cutout portion (42) formed in connection with the recessed area (24) for advantages such as to accommodate at least one finger of the user, as per the teachings of Bennage et al.(col. 2, lines 62-63).

Accordingly, claims 13 -14 would have been obvious.

Response to Argument

13. Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

14. Applicant's main argument is directed to the feature recited in claim 1 of a charger shell comprising at least one detachably mounted bit holder for storing tool inserts, particularly screwdriver bits, of the battery-operated screwdriver in captive fashion.

15. Examiner respectfully submits that the argument is moot in view of the new rejection US PAT 6,191,554 issued to Nakane, who discloses a detachable charger shell (31) which includes a display window (27d) and a plurality of cylindrical tool bit holders (46) for inserting tool bit (47). The tool (30) includes a hydraulic unit (32)

coupled to a nose or chuck (driven unit) (32a) to which a tool bit is attached (see col. 7, lines 23-35; col. 8, lines 1-50).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M'baye Diao whose telephone number is 571-272-6127. The examiner can normally be reached on 8:30-5:00; First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Akm Ullah can be reached on Monday through Friday at 571-272-2361. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M'baye Diao/
Examiner, Art Unit 2838

/M. D./

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Primary Examiner, Art Unit 2838